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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT PAPER NUMBER

1624

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/719,508

Applicant(s)

ZINDEL ET AL.

Examiner

Venkataraman
Balasubramanian

Art Unit

1624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See attached Advisory Action

ADVISORY ACTION

The amendment filed 11/07/2003 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered for the following reasons.

1. Claims 1-5, 7-10, and 12-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for chlorination of triazine compounds bearing R¹ as variously (un)substituted C₁-C₈ alkyl or C₃-C₈ cycloalkyl, does not reasonably provide enablement for alkenyl and alkynyl as substituents in the above said R¹ groups. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicants' traversal is not persuasive. Applicants argue that the said groups do not end up in the final product and therefore not relevant.

Examiner disagrees. First of all, these groups would react with chlorine and therefore there will be some chlorinated product and the starting material would be consumed and hence the desired product yield will decrease.

Secondly applicants are asserting that the instant process is unexpected superior yield of the final chlorinated product but it is not clear how would one expect higher yield if the starting material is used up in a different unwanted process.

Note Ex parte Gelles 22 USPQ 2nd 1318, especially the following quote: " The evidence relied upon also should be reasonably commensurate in scope with the

subject matter claimed and illustrate the claimed subject matter " as a class" relative to prior art subject matter."

Hence this rejection is proper and is maintained.

2. Claims 1-5, 7-10, and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giencke et al. WO 97/08156 or Lorenz et al. US 6,069,114 in view of Chakrabarti et al., Tetrahedron, 31(16) 1879-1882, 1975 for reasons of record.

Applicants' traversal to overcome this rejection is not persuasive. Applicants have once again argued that there is no *prima facie* case made.

As can be seen in the previous office action, all the three references teach the chlorination process with the displacement of alkylmercapto group by chlorine.

To repeat:

The primary references teach chlorination of alkylthio-triazine to make corresponding chloro-triazine and the secondary reference teaches enablement of the chlorination process. In addition the primary reference teaches the temperature range and choice of suitable solvents. Hence it would motivate one trained in the art to optimize the process of chlorination with the combined teachings.

There is *prima facie* obviousness.

Without conceding to the above, applicants argue that the rejection is unwarranted as the comparative of record is sufficient to overcome the obviousness rejection.

Examiner disagrees. The rejection is warranted. Although a yield of 60-80 % of examples a to e of the instant chlorination process would definitely suggest unexpected/superior results, the comparison as detailed in example f is not proper comparison. Examples a to e have too many variations from the comparative example f. This regards, applicants attention is drawn to MPEP 716.02(e) and MPEP 2145 which states the following:

Comparison With Closest Prior Art

An affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness. In re Burckel, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979). "A comparison of the claimed invention with the disclosure of each cited reference to determine the number of claim limitations in common with each reference, bearing in mind the relative importance of particular limitations, will usually yield the closest single prior art reference." In re Merchant, 575 F.2d 865, 868, 197 USPQ 785, 787 (CCPA 1978) (emphasis in original). Where the comparison is not identical with the reference disclosure, deviations therefrom should be explained, In re Finley, 174 F.2d 130, 81 USPQ 383 (CCPA 1949), and if not explained should be noted and evaluated, and if significant, explanation should be required. In re Armstrong, 280 F.2d 132, 126 USPQ 281 (CCPA 1960) (deviations from example were inconsequential).

Comparisons when they are two equally close prior art references

Showing unexpected results over one of two equally close prior art references will not rebut prima facie obviousness unless the teachings of the prior art references

are sufficiently similar to each other that the testing of one showing unexpected results would provide the same information as to the other. In re Johnson, 747 F.2d 1456, 1461, 223 USPQ 1260, 1264 (Fed. Cir. 1984).

The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).

In the instant case the specification is totally silent about the variations in the comparison of example f and example a-e. See pages 15-17. Note examples a to e has too many variations from that of example f.

Furthermore, the primary references clearly teach the temperature range and use of inert solvent and mentions some such solvents. Applicants have not shown that the instant process would give high yield only with the limitations stated therein and that it would not be possible for one trained in the art to use solvents/ temperature taught by the prior art Giencke et al. or Lorenz et al. to arrive at a high yield process.

As for applicants' argument that in view of the low yield of chlorination of Chakrabarti, one would not have transfer the conditions to chlorination of methylthio-aminotriazines, both the primary reference cite the Chakrabarti reference for the chlorination process and there is clear-cut suggestion that one would be able to use as is or modify and use the conditions of chlorination of Chakrabarti.

As for comparative data, again the comparison appears to be not proper. There appears to be some inconsistency in the argument. In one hand applicants argue that prolongation/variation reaction time would not have improved the yield but on the other

hand applicants assert that the amount of staring material in example (f) is reduced which results in quick reaction. If so, how can it be a proper comparison?

Hence the rejection is proper and is maintained.

Conclusion

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (703) 308-4716.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

V. Balasubramanian
Venkataraman Balasubramanian

12/01/2003